

REMARKS/ARGUMENTS

The amendments set out above and the following remarks are responsive to the points raised in the Office Action dated April 26, 2010, and discussed during the telephonic interview with Examiners Lewis and Ross on August 17, 2010. In view of the amendments set out above and the following remarks, reconsideration is respectfully requested.

As an initial point, the Applicant's representative greatly appreciates the courtesy shown her by Examiners Lewis and Ross, and further appreciates their careful consideration of the arguments presented during the interview.

The Pending Claims

Claims 3, 8-9, and 13 are cancelled, so that claims 1-2, 4-7, 10-12, 14-16, and 18 are pending. Claim 1 is amended to include the limitations of claim 17, which is cancelled, and to describe the invention more clearly. Claim 18 is also amended to describe the invention more clearly. No new matter is added, and support for the amended claim language may be found within the original specification, claims, and drawings. Support for claims 17 and 18 may be found in the specification at, e.g., page 3, paragraph [0029] and Figures 1-4.

The Office Action

Claims 1-4, 6, 10-12 and 16 were rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent Application Publication No. 2004/0136774 to O'Boyle (hereinafter, "O'Boyle") in view of U.S. Patent Application Publication No. 2003/0030269 to Hernandez (hereinafter, "Hernandez") and further in view of U.S. Patent No. 4,932,520 to Ciarcia et al. (hereinafter, "Ciarcia").

Claims 5 and 15 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 5,651,628 to Bankes et al. (hereinafter, "Bankes").

Claim 7 was rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2002/0089166 to Schwartz (hereinafter, "Schwartz").

Claims 8-9 and 13-14 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2004/0253046 to Africa (hereinafter, "Africa").

Claims 17-18 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 2,551,784 to Bauer (hereinafter, "Bauer").

Each of these rejections is separately and respectfully traversed.

Amended independent claims 1 and 18 are each directed to a filing notebook comprising, *inter alia*, at least one closing means including an elastic band fastened by rivets to one of the front and back leaves via eyelets, the elastic band sliding relative to *the external face of the leaf*. Each of amended independent claims 1 and 18 recite that the elastic band is adapted to be pulled over corners of the superimposed inner separation sheets (claim 1) or the folded-down flaps storing inner separation sheets (claim 18).

O'Boyle discloses a notebook 10 comprising a cover including a front leaf 17 and a back leaf 18, a binder (spiral binding 11) joining the front and back leaves together, and inner notebook pages 16 connected to the binder between the front and back leaves. Hernandez discloses pages separable via perforations (par. [0054]). The Office Action correctly acknowledges that O'Boyle fails to disclose inner separation sheets with tabs inseparably connected to the binder for filing notebook pages separated from the binder between adjacent inner separation sheets of the notebook.

Ciarcia discloses a plurality of clear plastic envelopes (40) attached to one another to a binder (42) to which a backing backing securement flap (46) is attached (Figure 3). The securement flap (46) is inserted into the slot (26) on the inside face (24) of the right hand cover (14), parallel to the edge (15) joining the left hand cover to the right hand cover 14 (Ciarcia col. 3, lines 32-40).

The Office Action alleges that “Ciarcia teaches the concept of providing inner separation sheets (envelopes 40) with tabs (enclosures 52) inseparably connected to a binder for filing notebook pages separated from the binder between adjacent inner separation sheets of a notebook (Fig. 1)” (page 3, 2nd full paragraph of Office Action). The Office Action also states that “In proposing the combination of O’Boyle with Ciarcia, Examiner’s intent is and was to take the inseparably bound separation sheet of Ciarcia fig. 3 and inseparably bind said sheet within the O’Boyle assembly” (page 11, 2nd full paragraph of Office Action).

However, it is not enough to render the claim obvious for Ciarcia to teach inner separation sheets (envelopes 40) with tabs (enclosures 52) inseparably connected to *a binder*, or to “take the inseparably bound separation sheet of Ciarcia fig. 3 and inseparably bind said sheet within the O’Boyle assembly,” as alleged in the Office Action. Amended independent claims 1 and 18 also require that inner separation sheets with tabs be inseparably connected to a “a binder *joining the front and back leaves together.*” Ciarcia’s teaching falls short of teaching or suggesting inner separation sheets with tabs inseparably connected to a binder that joins the front and back leaves together, as claimed in amended independent claims 1 and 18. In Ciarcia, it is clear that the binder (42) to which the envelopes (4) are attached is independent from the edge (15) binding the left and right hand covers (12, 14) of the wallet (see Ciarcia Figure 1). Thus, the binder (42) of Ciarcia is clearly distinguishable from a binder that joins the front and back leaves together, as claimed in claims 1 and 18, and the envelopes of Ciarcia are removably (not inseparably) inserted via insertion of the securement flap 46 into the slot 26 in the flap 14 (Ciarcia col. 3, lines 32-40). Combining Ciarcia and O’Boyle would only result in the assembly shown in Figure 3 of Ciarcia removably attached through the securement flap 46 into a slot on the inside face of one of the covers (17, 18) of the notebook (10) of O’Boyle. Thus, Ciarcia’s teaching falls short of teaching or suggesting each and every element of amended independent claims 1 and 18. Nor does the Office Action explain why it would be obvious to one of ordinary skill in the art to inseparably connect inner separation sheets with tabs to a “binder joining the front and back leaves together,” as claimed. Accordingly, the obviousness rejection of amended independent claims 1 and 18 cannot be maintained.

Even assuming, *arguendo*, that the combination of O'Boyle and Ciarcia teaches separation sheets inseparably bound to a binder joining the front and back leaves together, (and the applicants maintain that the combination of O'Boyle and Ciarcia does not teach this claim limitation), the obviousness rejection cannot be maintained because the cited combination of references fails to teach or suggest at least one closing means including an elastic band fastened by rivets to one of the front and back leaves via eyelets, the elastic band sliding relative to *the external face of the leaf*, as claimed in amended claims 1 and 18.

Bauer discloses a book protector including two flaps 22 which are folded over the two swinging side walls 20 of the book protector and which can engage the inside surface of the covers of a book (Bauer, col. 1, lines 32-43). A piece of elastic cord 27 is supported at each of its ends by a corresponding fastener portion 24 of one flap 22 (Bauer, col. 2, lines 5-9). In use, the covers of a book are inserted in the pockets provided by the flaps 22 and the pages at the left and right sides of the book are held down by the elastic cords 27 (Bauer, col. 2, lines 10-23).

As shown in Figure 1 of Bauer, each piece of elastic cord 27 is fixed by each of its extremities to the *internal* face of the corresponding flap 22, in contrast to the claimed notebook, which has an elastic band fastened by rivets to one of the front and back leaves, the elastic band sliding relative to *the external* face of the leaf.

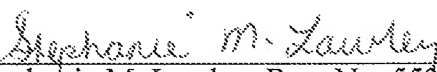
The teaching of Bauer would lead one of ordinary skill in the art to attach the extremities of a piece of elastic cord to the *internal* face of the front cover 17 or the back cover 18 of the notebook 10 of O'Boyle, with these two extremities located in the vicinity of the binding 11 connecting the front and back covers (17, 18) together. With the elastic cord in this position, the detachable notebook pages and the separation sheets with tabs would be covering the piece of elastic cord. Accordingly, it would be problematic to adapt the elastic cord to be pulled over corners of the superimposed inner separation sheets (claim 1) or the folded-down flaps storing inner separation sheets (claim 18), as claimed, because the piece of elastic cord would be located between the inner separation sheets and one of the front and back covers (17, 18) of the notebook 10 of O'Boyle. Accordingly, the obviousness rejection of amended independent claims 1 and 18 cannot be maintained.

The dependent claims are also patentable because they depend from, and include the limitations of, patentable amended independent claim 1.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


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Amendment or ROA - Regular (SML/mlg)